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09/692,031	10/19/2000	Richard Baker Winslow	37631/DWR/S850	5435
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CHRISTIE, PARKER & HALE, LLP			PHAM, HUNG Q	
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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/692,031

**Applicant(s)**

WINSLOW, RICHARD BAKER

**Examiner**

HUNG Q PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/26/2004 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to the rejection of claims 18-23 under U.S.C. § 112 have been fully considered but they are not persuasive.

As argued by applicants:

*Applicant respectfully submits that quoted limitation is fully supported in the specification. For example, starting on page 14, line 25 to page 16, line 19, the specification refers to different address books (applications) that may have different formats than a comma-separated value (CSV) format.*

However, as in the specification page 14, line 25-page 16, line 19, there is no description of *receiving address data formatted in accordance with a particular format from a plurality of possible formats*. And the address books come from different providers does not mean the address books may have different format as argued by applicant.

In addition, as disclosed in the specification on page 15, lines 1-7:

*System 10 also provides software resident at each client 16 that allows for the importation of address data from various third party address books into the address book maintained by*

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*client 16. In one illustrative embodiment, client 16 maintains a plurality of address book providers 15 (FIG. 5), with each provider 15 being operative to interface with a corresponding external address book application.*

As seen, client 16 maintains a plurality of address book providers 15, but there is no description of *address data formatted in accordance with a particular format from a plurality of possible formats*. Therefore, the rejection of claims 18-23 is maintained as below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 18 contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed *address data formatted in accordance with a particular format from a plurality of possible formats* is not described in the specification.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 11-12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al. [USP 5,930,796].**

Regarding to claim 11, Pierce teaches a method of verifying the validity of an address (Abstract) by using a CD-ROM hosted USPS ZIP+4 National Directory to assign addresses with valid Delivery Point Bar Codes or DPBC's (Col. 4, Lines 11-15). As seen, the CD-ROM is *a database that stores a plurality of pre-approved addresses*. As shown in FIG. 2, is the step of *receiving the address from a user at a terminal* at block 100 (Col. 3, Lines 55-60). After the step of receiving, if the address is not valid, the system returns to step 112 to postal code the address (Col. 4, Lines 7-9). As shown in FIG. 3 is the process of postal coding an address and storing it in the database. At step 212, a check is made to determine if the address is valid using the CD-ROM hosted USPS ZIP+4 National Directory (Col. 4, Lines 17-23). As seen, the technique as discussed indicates the step of *accessing the database*, and *comparing the address from the user with the database of pre-approved addresses for validating the address*. Referring back to FIG.

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2, block 124 is the process of *printing a validated address on* the envelope as *the value bearing item* (Col. 3, Lines 58-60 and Col. 4, Lines 6-7). Referring back to FIG. 3, after block 212 of validating, postal code as *information relating to the validated address is stored in* address record (Col. 4, Lines 25-30) as *a companion file on the terminal upon a validation of the address*, and FIG. 5 is the structure of address record. Pierce does not explicitly teach the terminal is *remote from the database*, which is *on an address matching server*. However, as disclosed by Pierce, if the USPS permits postal coding by modem or over the internet as an alternate means, i.e. other than the CD-ROM hosted USPS ZIP+4 National Directory, the present invention avoids the need for a user to access such dial-up or internet service every time an indicia is being generated. Thus, other than a CD-ROM hosted USPS ZIP+4 National Directory, *a remote database*, which is on a server as *an address matching server* could be used. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Pierce technique by using a remote database, which is on a server in order to maintain, update the database quickly.

Regarding to claim 12, Pierce teaches all the claim subject matters as discussed in claim 11, Pierce further discloses the step of *receiving the address comprises importing the address from a database of addresses* (Col. 3, Lines 55-57).

Regarding to claim 14, Pierce teaches all the claim subject matters as discussed in claim 11, Pierce further discloses the step of *receiving a second*

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*address from the source; comparing selected information from the second address with stored information in the companion file; approving the address for use if the selected information corresponds with the stored information in the companion file; and accessing the database of valid addresses if no match is found* (Col. 3, Line 58-Col. 4, Line 30).

Regarding to claim 15, Pierce teaches all the claim subject matters as discussed in claim 14, Pierce further discloses the step of *comparing the second address with the stored addresses in the companion file comprises determining whether a stored address in the companion file is stale, and rejecting the stored address if it is stale* (Col. 2, Lines 44-60).

Regarding to claims 16 and 17, Pierce teaches all the claim subject matters as discussed in claim 11, but does not explicitly teach CD-ROM hosted USPS ZIP+4 National Directory is *a remote database over a communication network*, which is *maintained by a remote address matching server*. However, as disclosed by Pierce, if the USPS permits postal coding by modem or over the internet as an alternate means, i.e. other than the CD-ROM hosted USPS ZIP+4 National Directory, the present invention avoids the need for a user to access such dial-up or internet service every time an indicium is being generated. Thus, other than a CD-ROM hosted USPS ZIP+4 National Directory, *a remote database*, which is on a server as *an address matching server* could be used. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to

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modify the Pierce technique by using a remote database, which is on a server in order to maintain, update the database quickly.

**7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al. [USP 5,930,796] in view of Hooper et al. [USP 5,819,282].**

Regarding to claim 13, Pierce teaches all the claimed subject matters as discussed in claim 12, but fails to disclose: *the address from the database of addresses is saved as comma-separated value (CSV) data, and further including: determining selected characteristics of the database of addresses; and processing the CSV address data based on the characteristics of the database of addresses.* Hooper teaches a method for creating a database by storing a plurality of data objects in a memory. Each data object has attributes including a key value and a data value. The data objects are partitioned into a plurality of classes, each class having one or more members, each member including the same attributes of the data objects. An access method is defined for at least one member of a specific class to access the data objects of the specific class by key values (Hooper, Abstract). Hooper further discloses the data *from the database is saved as comma-separated value (CSV) data, and further including: determining selected characteristics of the database; and processing the CSV data based on the characteristics of the database* (FIG. 5-6, Col. 4, line 11-Col. 7, line 47). Therefore, it would have been obvious for one of ordinary skill in the art at the time the



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invention was made to modify the Pierce method by using the technique as taught by Hooper for saving the address data as CSV data, determining, and processing the CSV address in order to have an easier, and faster way for manipulating data in an address database.

**8. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al. [USP 5,930,796] in view of Wesinger, Jr. et al. [USP 6,324,538 B1].**

Regarding to claim 18, Pierce teaches a method of verifying the validity of an address (Abstract) by using a CD-ROM hosted USPS ZIP+4 National Directory to assign addresses with valid Delivery Point Bar Codes or DPBC's (Col. 4, Lines 11-15). As seen, the CD-ROM is *a database that stores a plurality of pre-approved addresses*. As shown in FIG. 2, is the step of *receiving the address data* either a single address or a batch of addresses at block 100 (Col. 3, Lines 55-60). As seen, the arrangement of receiving address data either a single address or a batch of address as *a particular format from a plurality of possible format*. After the step of receiving, the address is entered into an address record with the structure as in FIG. 5 (Col. 3, Lines 60-64) as the step of *mapping the received address data with the particular format into a predetermined format*. As shown in FIG. 3, at block 212, a check is made to determine if the address is valid using the CD-ROM hosted USPS ZIP+4 National Directory (Col. 4, Lines 17-23). As seen, the technique as discussed indicates the step of *comparing the address data*

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*in the predetermined format with pre-approved addresses in the database for validating the address.* Referring back to FIG. 2, block 124 is the process of *printing a validated address on the envelope as the value bearing item* (Col. 3, Lines 58-60 and Col. 4, Lines 6-7). Pierce does not explicitly teach the step of *presenting the results if one or more matches are found*. However, returning the result of a search if a match is found is a conventional technique, such technique could be found in USP 6,324,538 B1 as discussed in previous actions. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include the step of presenting the result in order to double check the address before printing.

Regarding to claims 19 and 20, Pierce teaches all the claimed subject matters as discussed in claim 18, but does not explicitly teach the step of *accessing a remote database of addresses over a communication network, and the database is maintained by a remote address matching server*. However, as disclosed by Pierce, if the USPS permits postal coding by modem or over the internet as an alternate means, i.e. other than the CD-ROM hosted USPS ZIP+4 National Directory, the present invention avoids the need for a user to access such dial-up or internet service every time an indicia is being generated. Thus, other than a CD-ROM hosted USPS ZIP+4 National Directory, *a remote database*, which is on a server as *an address matching server* could be used. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to

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modify the Pierce technique by using a remote database, which is on a server in order to maintain, update the database quickly.

Regarding to claim 21, Pierce and Wesinger teaches all the claimed subject matters as discussed in claim 18, Wesinger further discloses the step of *applying a plurality of query permuters to the address data to convert the data into respective formats* (Wesinger, FIG. 2K).

Regarding to claim 22, Pierce and Wesinger teaches all the claimed subject matters as discussed in claim 21, Wesinger further discloses the step of *applying at least one of a direct permuter and a single line permuter to the address data* (Wesinger, FIG. 2K).

Regarding to claim 23, Pierce and Wesinger teaches all the claimed subject matters as discussed in claim 22, Wesinger further discloses the step of *applying a truncate permuter to the output structure of the direct permuter* (Wesinger, Col. 8, lines 37-52).

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**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 703-605-4242. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham  
June 18, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER